

REMARKS

In the Office action mailed 05/27/04, claims 1, 3-10, 12-21, and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's prior art in view of Bontemps et al. (U.S. Pat. No. 5,923,663).

Applicant respectfully submits that the 35 U.S.C. 103(a) rejection is unwarranted as no suggestion to combine the references appears in the prior art.

MPEP 2143 BASIC REQUIREMENTS OF A PRIMA FACIE CASE OF OBVIOUSNESS
To establish a prima facie case of obviousness, three basic criteria **must** be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT IN THE APPLICANT'S DISCLOSURE.**

In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, **and** a teaching of each and every claimed element (emphasis added). Id.

The 35 U.S.C. 103(a) rejection rests on the limitations of independent claim 1, which are also present in independent claims 10 and 18, and thus the following argument applies to all currently pending, independent claims of the present application. In the response mailed 3/17/04, Applicant's attorney argued that Bontemp is teaching *a method of detection of a device to a port and not the presence of the port on the router*, and thus neither are all elements of the claim met nor is there a suggestion to combine or modify the references. In response this argument, the Examiner cited Bontemp at col. 3, line 66 through col. 4, line 4 as providing the suggestion to combine. However, this portion of

Bonham merely supports the argument made by the Applicant's attorney, that Bontemp is teaching *a method of detection of a device to a port and not the presence of the port on the router*. Bontemp at col. 3, line 66 through col. 4, reads:

If the link detect signal is subsequently negated thereby indicating subsequent loss of valid communication signals, the control circuit preferably returns to the toggle mode to detect another device coupled to the port (emphasis added). Thus, communication links are established and reestablished without trial and simply by connecting the cable interfaces together.

There is no mention here or elsewhere in Bontemp of detecting the presence of a port on a router.

If the Examiner is claiming that such motivation would be commonly known in the art, Applicants challenge this assertion and demand evidence proving this as is required under §2144.03 of the MPEP. Otherwise, the rejection cannot be maintained.

Respectfully submitted,
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